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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,725	01/17/2001	Richard L. Maliszewski	42390P6532C	8454

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EXAMINER

KISS, ERIC B

ART UNIT PAPER NUMBER

2192

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/764,725	Applicant(s) MALISZEWSKI, RICHARD L.	
	Examiner Eric B. Kiss	Art Unit 2192	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-9 and 11-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-9 and 11-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. The reply filed 14 January 2005 has been received and entered. Claims 1, 3-5, 7-9, and 11-16 are pending.

Response to Arguments

2. Applicant's arguments filed 14 January 2005 have been fully considered but they are not persuasive.

In response to Applicant's argument that the references fail to show certain features of Applicant's invention, it is noted that the features upon which applicant relies (i.e., the instructions in the new executable, as a whole, being overall smaller in size than the instructions in the old executable, as a whole) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by International Publication No. WO 97/04394 to Drake.

As per claim 13, Drake discloses transferring control to a software test module when a second instruction having an instruction address in the instructions is executed by a data processing device, the second instruction replacing a non-identical first instruction comprising a target address (see, for example, page 16, lines 20-32), the first instruction to invoke a function or procedure (the designated Part B, 94 in Fig. 9, is part of code area 72 which contains the machine instructions for operation on the x86 microprocessor; see p. 15, lines 36-38 and p. 16, lines 20-25), and the first instruction comprising more bytes than the second instruction (the designated Part B, 94 in Fig. 9, is specifically chosen because it is greater in size than the “netsafe 1 code”; see p. 16, lines 22-25);

a test module comprising a table comprising a target address of the replaced first instruction (see, for example, page 16, lines 26-32); and test instructions to produce a test result by performing a test on the instructions, the test module to locate the target address in the table and to transfer control to the target address if the test result indicates the instructions are to proceed (see, for example, page 18, line 28, through page 19, line 6).

As per claim 14, Drake further discloses loading the test module (see, for example, page 15, lines 8-11).

As per claim 15, Drake further discloses the test module comprising instructions to set an exception handler to transfer control to the test instructions when the second instruction is executed by the data processing device (see, for example, page 19, lines 14-18).

As per claim 16, Drake further discloses the test module comprising instructions moved from the instructions, the instructions moved to make room in the instructions for the instructions to load the test module (see, for example, page 16, lines 26-32).

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1, 3-5, 7-9, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over International Publication No. WO 97/04394 to Drake in view of U.S. Patent No. 5,966,541 to Agarwal.

As per claims 1, 5, and 9, *Drake* discloses generating a software test module to produce a test result by performing a test on instructions (see, for example, page 14, line 34, through page 15, line 5; and page 16, line 6, through page 17, line 23); in the instructions, replacing a first instruction comprising a target address, the first instruction to invoke a function or procedure (the designated Part B, 94 in Fig. 9, is part of code area 72 which contains the machine instructions for operation on the x86 microprocessor; see p. 15, lines 36-38 and p. 16, lines 20-25), and the first instruction comprising more bytes than the second instruction (the designated Part B, 94 in Fig. 9, is specifically chosen because it is greater in size than the “netsafe 1 code”; see p. 16, lines 22-25), with a second non-identical instruction having an instruction address in the instructions, the second instruction to transfer control to the test module (see, for example, page 16, lines 20-32); and storing the target address encrypted in a table, the test module to locate the target address in the table and to set an execution address to the target address if the test result indicates the instructions are to proceed (see, for example, page 15, lines 8-11; and

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page 17, line 21, through page 18, line 27). Drake fails to expressly disclose compacting the instructions to eliminate a hole created by replacing the first instruction with the second instruction. However, Agarwal teaches that it is known to shift a set of instructions in conjunction with the act of inserting or removing an instruction (see, for example, column 7, lines 20-26; note that replacing an instruction is the equivalent of inserting a new instruction and deleting an old instruction). Therefore, it would have been obvious to one having ordinary skill in the computer art at the time the invention was made to modify the invention of Drake to include compacting instructions to eliminate a hole created by replacing an instruction. One would be motivated to do so to prevent invalid op codes, as an artifact of a replaced instruction, from remaining in a set of instructions.

As per claims 3, 7, and 11, *Drake* further discloses corresponding the target address with the instruction address in the encrypted table (see, for example, page 18, line 28, through page 19, line 6).

As per claims 4, 8, and 12, *Drake* further discloses profiling the instructions to identify the first instruction as an instruction to replace (see, for example, page 16, lines 20-25).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric B. Kiss whose telephone number is (571) 272-3699. The Examiner can normally be reached on Tue. - Fri., 7:00 am - 4:30 pm. The Examiner can also be reached on alternate Mondays.

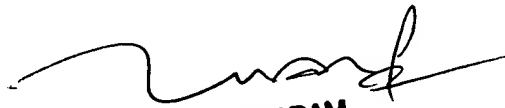
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam, can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature should be directed to the TC 2100 Group receptionist:
571-272-2100.

EBK / EBK
April 7, 2005



TUAN DAM
SUPERVISORY PATENT EXAMINER